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04/05/2005

Haruhiko Habuta

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12/15/2008

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EXAMINER

HIGGINS, GERARD T

ART UNIT

PAPER NUMBER

1794

MAIL DATE

DELIVERY MODE

12/15/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

DETAILED ACTION

Response to Amendment

1. Applicant's amendment filed 12/02/2008 will not be entered because it requires new search and consideration. The Examiner did not search for a disc wherein the "low refractive index layer being provided between and ***in contact with*** the transmittance adjusting layer ***and*** the first optical separating layer" (emphasis added).

With regard to applicants' arguments on page 4 of their Remarks concerning the intended use of their low refractive index layer it is noted that the features upon which applicant relies (i.e., preventing the transmittance adjusting layer from being affected by moisture) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Additionally, even if these features were in the recited claims (i.e. preventing the transmittance adjusting layer from being affected by moisture), the Examiner notes that intended use limitations are not dispositive of patentability; furthermore, the Examiner notes that given the fact that the device of Higuchi et al. reads on applicants' recording medium and that the material of the low refractive index layer is identical to those suggested by applicants, it will inherently perform the intended use limitation.

With regard to applicants' argument that Higuchi et al. fails to disclose a rewriteable optical recording medium, it is noted that the features upon which applicant relies (i.e., a rewriteable optical recording medium) are not recited in the rejected

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claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). Reading of information contained within the optical disc using a laser as taught by Higuchi et al. reads on applicants' claimed limitation that "information is...reproduced by irradiation of a laser beam."

With regard to applicants assertion that claim 1 is not a product-by-process claim, the Examiner will accede the fact that the limitations wherein "the low refractive index layer being formed on the optical separating layer, and the transmittance adjusting layer being formed on the low refractive index layer" are not product-by-process limitations; rather, they represent relative positions of the layers. This change in the Examiner's stance is brought about because of applicants' amendment and Remarks that the abovementioned limitations are not product-by-process in nature.

With regard to applicants' arguments on page 5 that the Examiner is without basis to state that the layers **7a** and **7b** can be rearranged, the Examiner respectfully disagrees. The Higuchi et al. reference provides a suggestion that the layers can be rearranged; furthermore, with regard to the low refractive index layer position, the Examiner notes that the low refractive index layer is a mere dielectric layer. Dielectric layers are ubiquitous in the art of optical recording media, and it would have been obvious to place a dielectric layer at any point in the recording stack, including those places claimed, in order to provide the proper protection, moisture resistance, and heat resistance. Higuchi et al. specifically state that their dielectric layer provides moisture

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resistance, and it would have been obvious to provide that moisture resistance to any layer comprising a metal such that it would limit corrosion.

Conclusion

2. Any inquiry concerning this communication or earlier communications from the examiner should be directed to GERARD T. HIGGINS whose telephone number is (571)270-3467. The examiner can normally be reached on M-F 9:30am-7pm est. (1st Friday off).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Callie Shosho can be reached on 571-272-1123. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Gerard T Higgins
Examiner
Art Unit 1794

/Gerard T Higgins/
Examiner, Art Unit 1794

/Callie E. Shosho/
Supervisory Patent Examiner, Art Unit 1794